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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,566	03/01/2002	Masahiro Furo	134.142	3943

7590 12/12/2005
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EXAMINER

XU, LING X

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,566

Applicant(s)

FURO ET AL.

Examiner

Ling X. Xu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/7/2005.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/7/2005 has been entered.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 25-28, 30-32 and 35-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ning et al. (US 5,965,193) in view of Boutin et al (US 4,222,774) for the reasons set forth in the Office action dated 11/1/2004.

3. Claims 29 and 33-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ning and Boutin, as applied to claims 25-28, 30-32 and 35-36 above, and further in view of Auran et al. (US 6,153,025) for the reasons set forth in the Office action dated 11/1/2004.

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4. Claims 49-52, 54-56 and 59-60 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hiyoshi et al. (US 6,297,549) in view of Ning et al and Boutin et al for the reasons set forth in the Office action dated 11/1/2004.

5. Claims 53 and 57-58 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hiyoshi, Ning and Boutin, as applied to claims 49-52, 54-56 and 59-60 above, and further in view of Auran et al. (US 6,153,025) for the reasons set forth in the Office action dated 11/1/2004.

6. Claims 37-40, 42-44, 47-48, 61-68 and 71-72 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 6,122,170) in view of Boutin et al (US 4,222,774) for the reasons set forth in the Office action dated 11/1/2004.

7. Claims 41, 45-46, 65 and 69-70 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose and Boutin, as applied to claims 37-40, 42-44, 47-48, 61-68 and 71-72 above, and further in view of Auran et al. (US 6,153,025) for the reasons set forth in the Office action dated 11/1/2004.

Response to Arguments

8. With respect to the rejection under 35 USC 102(e) based on Copetti, applicant's arguments filed on 11/7/2005 have been fully considered and are persuasive. The rejection based on Copetti et al has been withdrawn.

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With respect to the rejections under 35 USC 103(a), Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that a Vickers hardness of an alloy may vary according to a process of hardening even if the compositions are the same.

As stated in the prior Office action, the cited references disclose same metal alloy layer or the module comprising the same metal alloy layer as claimed, the same metal alloy layer would have the same properties as claimed such as Vickers hardness.

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985), *see* MPEP 2112.01 [R-3].

The arguments of counsel cannot take the place of evidence in the record. Applicant has not provide sufficient evidence to show that prior art products do not necessarily possess the characteristics of the claimed product. The specification of the present application only recites that the Vickers harness varies according to the composition of the alloy material, see Tables 1-5 of the present application.

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Applicant also argues that the specification as filed does show that the Vickers hardness of the alloy material may vary accordingly to the process of making the alloy material.

Applicant cited the different Vickers hardness between Examples 9 and 20, Examples 2 and 6, Examples 14 and 25, Examples 15 and 26, Examples 16 and 27, Examples 17 and 28, Examples 18 and 29.

The Vickers harness of the alloy materials made by different process in the Examples cited above are only different by 1, which is very insignificant. In fact, the insignificant difference of the Vickers hardness of the alloy material between the Examples may provide evidence to show that the Vickers harness does not significantly change when the process of making the alloy material changes. In addition, the Vickers hardness of the alloy materials in the Examples cited above are all within the range as claimed even when the processes of making the alloy material are different. Accordingly, there is still insufficient evidence in the specification to show that the Vickers harness of the alloy material varies according to the process of making the alloy material.

Conclusion

9. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

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See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 571-272-1546. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ling X. Xu
Primary Examiner
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